

ESTTA Tracking number: **ESTTA667545**Filing date: **04/20/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	W.W. Grainger, Inc.
Granted to Date of previous extension	04/19/2015
Address	100 Grainger Parkway Lake Forest, IL 60045 UNITED STATES
Attorney information	Mark R. Galis Greenberg Traurig, LLP 77 W. Wacker Drive Suite 3100 Chicago, IL 60601 UNITED STATES chiipmail@gtlaw.com, galism@gtlaw.com, dunningj@gtlaw.com, horwitzb@gtlaw.com Phone:312.456.8400

Applicant Information

Application No	85909714	Publication date	10/21/2014
Opposition Filing Date	04/20/2015	Opposition Period Ends	04/19/2015
International Registration No.	NONE	International Registration Date	NONE
Applicant	Princess Auto Ltd. 475 Panet Road Winnipeg, Manitoba, R3C2W7 CANADA		

Goods/Services Affected by Opposition

Class 007. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Machine tools for breaking up road surfaces; paint spray guns; air and airless power-operated sprayers; pneumatic grease guns; mobile electric power generators; electric generators; gas operated power generators; sand-blasting apparatus; nozzles being structural parts of sand-blasting apparatus; sandblast hoods being structural parts of sand-blasting apparatus; sand blast cabinets being structural parts of sand-blasting apparatus; multi-purpose high pressure washers; electric multi-purpose high pressure washers; gas powered multi-purpose high pressure washers; hydraulic jacks; regulators being parts of machines; pneumatic air preparation equipment, namely, lubricators being parts of machines; air powered tools, namely, air rivet hammers; air grinders; electric grinders; air powered tools, namely, air saws; power-operated diamond saws; power-operated reciprocating saws; air powered tools, namely, air rivet hammers; bench grinders; air-operated power tools, namely, orbital sanders; air powered tools, namely, air drills; powerdrill bits; chucks for power drills; winches; circular saws; earth moving machines, namely, scrapers; die-cutting machines; power operated air shears; metal benders, namely, bending machines; pipe benders, namely, bending machines; impact wrenches; impact socket wrenches and

structural parts therefor; presses, namely,hydraulic shop presses; wire brushes for use in machines; band saws; power tools, namely, drill presses; electronicallyand power operated tools, namely, nut splitters and screw extractors; taps; pneumatic air preparation equipment, namely, lubricators being parts of machines; fuel filters; regulators being parts of machines; oil water separators for pneumatic controls being parts of machines; gas engines not for land vehicles; electric motors for machines; hydraulic pumps; transmission gears for machines. bits, namely, power drill bits; machine parts, namely, couplers of synthetic material; electric welding machines; gas welding machines; electric glue guns; hoists; non-electric cables for lifts; piston rings; spark plugs; repair kits for power operated spray guns comprised structural repair parts and fittings for power operated spray guns; trailer jacks, namely, trailer mounted hydraulic jacks; wire wheels for power-operated grinders; snowmobile accessories, namely, power operated lifts for moving, parking and storing land vehicles in the nature of snow mobiles; power operated sprayers

Class 008. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Manually-operated grease guns; tool carriers in the nature of tool belts; tool aprons; tool belts; hand tools, namely, tapered reamers; screw-drivers; hand tools, namely, hex keys wrenches; hammers; shears; mallets; axes; pliers; chisels; wrenches; hand tools, namely, drills; bits for hand drills; hand tools, namely, socket sets; hand tools, namely, ratchet wrenches; saws and hand saw blades; crowbars; hand tools, namely, riveters; files; hand tools, namely, die and punch sets; hand tools, namely, punches and chisel files; tin snips; hand tools, namely,flange punches; caulking guns; metal vises; hand operated pipe cutters; hand tools, namely, hole saws; hand tools, namely, dies; bits, namely, bits for hand drills; hand jacks and hand jack stands; floor manually-operated jacks; manually-operated transmission jacks; manually-operated farm jacks; pipe wrenches; hand tools, namely, crimping irons; wire strippers; manual hoists; number and letter stamp kits comprised of hand tools, namely, stamps; sharpening stones; trailer jacks, namely, trailer mounted non-hydraulic jacks; leather punch and stud kits comprised of hand tools, namely, punches; tweezers; scissors; hobby knives, namely,utility knives, jack knives, and pocketknives; knife sets comprised of two or more utility knives, jack knives, and pocket knives; locking pliers; hand tools,namely, nut drivers; hand tools, namely, log splitters; gardening hand tools, namely, manure forks, rakes, shovels, spades, feed scoops, and picks in the nature of hand tools


Class 035. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: On-line retail store services featuringworkshop tools and equipment, trailer parts and accessories, truck accessories,hydraulics and drive components, power tools for gardening, agriculture and outdoor maintenance; mail order catalog services featuring workshop tools and equipment, trailer parts and accessories, truck accessories, hydraulics and drive components, power tools for gardening, agriculture and outdoor maintenance

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2660099	Application Date	02/09/2000
Registration Date	12/10/2002	Foreign Priority Date	NONE
Word Mark	POWER FIRST		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 009. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Electrical power extension cords, electrical and communication cable, parallel ground adapters, battery and cable electrical connectors, electrical wire connectors, electrical conduit connectors, [electrical switch boxes] and switch plates, electrical outlet boxes and covers, electrical power strips, voltage surge protectors, electric wall switches, [telephone cord jacks, telephone cord couplers,] electrical wires, electricity conduit boxes, [electricity conduit body covers,electrical boxes and box covers,] electrical receptacles, and ground fault circuit interrupter receptacles

U.S. Registration No.	2821454	Application Date	02/09/2000
Registration Date	03/09/2004	Foreign Priority Date	NONE


Word Mark	POWER1 FIRST
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Design Mark	
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Description of Mark	The mark consists, in part, of "POWER 1FIRST".
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Goods/Services	Class 009. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Electrical power extension cords,[electrical and communication cable, parallel-ground adapters,] battery and cable electrical connectors, electrical wire connectors, electrical conduit connectors, electrical switch boxes and switch plates, electrical outlet boxes and covers, electrical power strips, voltage surge protectors, electric wall switches, [telephone cord jacks, telephone cord couplers, electrical wires, electricity conduitboxes, electricity conduit body covers,electrical boxes and box covers, electrical receptacles,] and ground fault circuit interrupter receptacles Class 017. First use: First Use: 2000/02/00 First Use In Commerce: 2000/02/00 Electrical tapes[, non-metal conduit gaskets]
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U.S. Registration No.	4428924	Application Date	05/03/2013
Registration Date	11/05/2013	Foreign Priority	NONE

		Date	
Word Mark	POWER FIRST		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 2007/11/00 First Use In Commerce: 2007/11/00 Metal conduit; metal nuts; metal pipe couplings and joints</p> <p>Class 009. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 Adapter plugs; circuit breakers; coaxial cables; wire terminals; electric connectors; distribution boxes for electrical power; electric switches; electric outlets; electric plugs; electric terminal blocks; protective covers for electric switches; insulated electrical connectors; inverters; floor power cable covers and power cable protectors; surge protectors; hand-held and wheeled storage reels for electric wire</p> <p>Class 017. First use: First Use: 2000/03/00 First Use In Commerce: 2000/03/00 Electrical tape; heat shrink tubing for covering electrical wire</p> <p>Class 022. First use: First Use: 2013/02/00 First Use In Commerce: 2013/02/00 Plastic cable ties</p>		

U.S. Registration No.	4388987	Application Date	03/28/2012
Registration Date	08/20/2013	Foreign Priority Date	NONE
Word Mark	POWER FIRST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2012/11/00 First Use In Commerce: 2012/11/00 Batteries		

Attachments	75925255#TMSN.png(bytes)
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	75925349#TMSN.png(bytes) 85923185#TMSN.png(bytes) 85581982#TMSN.png(bytes) Notice of Opposition.pdf(405569 bytes) Exhibit 1.pdf(374811 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jeffrey P. Dunning/
Name	Jeffrey P. Dunning
Date	04/20/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85/909,714
Published October 21, 2014.

W.W. GRAINGER, INC.,)	
)	
Opposer,)	
)	
v.)	OPPOSITION NO.
)	
PRINCESS AUTO LTD.)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION


Opposer, W.W. GRAINGER, INC., a corporation duly organized and existing under the laws of the State of Illinois, having a principal place of business at 100 Grainger Parkway, Lake Forest, Illinois 60045, believes that it may be damaged by registration of the mark shown in Application Serial No. 85/909,714 and accordingly opposes same.

As grounds for this opposition, it is alleged that:

1. Applicant, PRINCESS AUTO LTD., filed Application Serial No. 85/909,714 on April 19, 2013 seeking registration of the mark "POWER FIST & Design" for goods in International Classes 7 and 8 and services in International Class 35, as indicated by the publication in the October 21, 2014 *Official Gazette*.

2. Long prior to Applicant's priority date, Opposer, by and through its related companies, including subsidiaries, has been continuously using its "POWER FIRST" and "POWER FIRST & Design" marks on a wide variety of products in multiple International Classes.

3. Opposer is the owner of the following United States trademark registrations:

Mark	U.S. Reg. No. / Reg. Date	Goods	Date of First Use
POWER FIRST	2,660,099 December 10, 2002	Int'l Class 9: Electrical power extension cords, battery and cable electrical connectors, electrical wire connectors, electrical conduit connectors, electrical switch boxes and switch plates, electrical outlet boxes and covers, electrical power strips, voltage surge protectors, electric wall switches, and ground fault circuit interrupter receptacles	At least as early as August 2000
	2,821,454 March 9, 2004	Int'l Class 9: Electrical power extension cords, battery and cable electrical connectors, electrical wire connectors, electrical conduit connectors, electrical switch boxes and switch plates, electrical outlet boxes and covers, electrical power strips, voltage surge protectors, electric wall switches, and ground fault circuit interrupter receptacles	At least as early as August 2000
POWER FIRST	4,428,924 November 5, 2013	Int'l Class 6: Metal conduit; metal nuts; metal pipe couplings and joints	At least as early as November 2007
		Int'l Class 9: Adapter plugs; circuit breakers; coaxial cables; wire terminals; electric connectors; distribution boxes for electrical power; electric switches; electric outlets; electric plugs; electric terminal blocks; protective covers for electric switches; insulated electrical connectors; inverters; floor power cable covers and power cable protectors; surge protectors; hand-held and wheeled storage reels for electric wire	At least as early as February 1999
		Int'l Class 17: Electrical tape; heat shrink tubing for covering electrical wire	At least as early as March 2000
POWER FIRST	4,388,987 August 20, 2013	Int'l Class 22: Plastic cable ties	At least as early as February 2013
		Int'l Class 9: Batteries	At least as early as November 2012

Copies of the United States trademark registration certificates for each of the above trademark registrations are attached as Exhibit 1.

4. Each of the above-listed U.S. trademark registrations are in full force and effect, and comprise *prima facie* evidence of the validity of the marks shown therein, of Opposer's ownership and of Opposer's exclusive right to use those marks in interstate commerce, and as constructive notice of Opposer's claim of ownership under Title 15 U.S.C. §§ 1057, 1072, and

1115. In addition, the first two registrations listed above—U.S. Reg. Nos. 2,821,454 and 2,660,099—have acquired the status of incontestability under Title 15 U.S.C. §1065.

5. Opposer will also rely on its common law rights resulting from its use of the “POWER FIRST & Design” and “POWER FIRST” marks in connection with goods and services.

6. Opposer’s “POWER FIRST & Design” and “POWER FIRST” marks and Applicant’s “POWER FIST & Design” mark are confusingly similar to each other in sight, pronunciation and sound. Opposer’s “POWER FIRST & Design” and “POWER FIRST” marks are completely fanciful, and should be accorded great scope and broad protection.

7. Opposer’s goods and Applicant’s goods are similar and/or related.

8. Accordingly, Opposer’s marks and Applicant’s mark are confusingly similar to one another.

9. Applicant’s “POWER FIST & Design” mark is deceptively similar to Opposer’s “POWER FIRST & Design” and “POWER FIRST” marks so as to cause confusion and lead to deception as to the origin of Applicant’s goods. If Applicant is permitted to register “POWER FIST & Design” for its goods, as specified in Application Serial No. 85/909,714, that mark is likely to cause confusion in the public and trade, resulting in damage and injury to Opposer, by reason of the similarity between Applicant’s “POWER FIST & Design” mark and Opposer’s “POWER FIRST & Design” and “POWER FIRST” marks.

WHEREFORE, Opposer prays that application Serial No. 85/909,714 opposed herein be rejected, that no registration be issued to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Dated: April 20, 2015

/s Jeffrey P. Dunning

Jeffrey P. Dunning

One of Attorneys for Opposer

Mark R. Galis
Jeffrey P. Dunning
Greenberg Traurig, LLP
77 West Wacker Drive, Suite 3100
Chicago, IL 60601
(312) 456-8400

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Princess Auto Ltd. by mailing said copy on April 20, 2015, via First Class Mail, postage prepaid to:

Cindy L. Caditz
Davis Wright Tremaine LLP
1201 3rd Avenue
Suite 2200
Seattle, Washington 98101-3045

/s/ Jeffrey P. Dunning

EXHIBIT 1

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,660,099

United States Patent and Trademark Office

Registered Dec. 10, 2002

**TRADEMARK
PRINCIPAL REGISTER**

POWER FIRST

W.W. GRAINGER, INC. (ILLINOIS CORPORATION)
100 GRAINGER PARKWAY
LAKE FOREST, IL 600455201

FOR: ELECTRICAL POWER EXTENSION CORDS, ELECTRICAL AND COMMUNICATION CABLE, PARALLEL GROUND ADAPTERS, BATTERY AND CABLE ELECTRICAL CONNECTORS, ELECTRICAL WIRE CONNECTORS, ELECTRICAL CONDUIT CONNECTORS, ELECTRICAL SWITCH BOXES AND SWITCH PLATES, ELECTRICAL OUTLET BOXES AND COVERS, ELECTRICAL POWER STRIPS, VOLTAGE SURGE PROTECTORS, ELECTRIC WALL SWITCHES, TELEPHONE CORD JACKS, TELEPHONE CORD COUPLERS, ELECTRICAL WIRES, ELECTRICITY CONDUIT BOXES,

ELECTRICITY CONDUIT BODY COVERS, ELECTRICAL BOXES AND BOX COVERS, ELECTRICAL RECEPTACLES, AND GROUND FAULT CIRCUIT INTERRUPTER RECEPTACLES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 8-0-2000; IN COMMERCE 8-0-2000.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "POWER", APART FROM THE MARK AS SHOWN.

SN 75-925,255, FILED 2-9-2000.

VIVIAN MICZNIK FIRST, EXAMINING ATTORNEY

Int. Cls.: 9 and 17

Prior U.S. Cls.: 1, 5, 12, 13, 21, 23, 26, 35, 36, 38, and 50

Reg. No. 2,821,454

United States Patent and Trademark Office

Registered Mar. 9, 2004

TRADEMARK
PRINCIPAL REGISTER



W.W. GRAINGER, INC. (ILLINOIS CORPORATION)

100 GRAINGER PARKWAY
LAKE FOREST, IL 600455201

FOR: ELECTRICAL POWER EXTENSION CORDS, ELECTRICAL AND COMMUNICATION CABLE, PARALLEL GROUND ADAPTERS, BATTERY AND CABLE ELECTRICAL CONNECTORS, ELECTRICAL WIRE CONNECTORS, ELECTRICAL CONDUIT CONNECTORS, ELECTRICAL SWITCH BOXES AND SWITCH PLATES, ELECTRICAL OUTLET BOXES AND COVERS, ELECTRICAL POWER STRIPS, VOLTAGE SURGE PROTECTORS, ELECTRIC WALL SWITCHES, TELEPHONE CORD JACKS, TELEPHONE CORD COUPLERS, ELECTRICAL WIRES, ELECTRICITY CONDUIT BOXES, ELECTRICITY CONDUIT BODY COVERS, ELECTRICAL BOXES AND BOX COVERS, ELECTRICAL RECEPTACLES, AND GROUND FAULT CIRCUIT

INTERRUPTER RECEPTACLES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 8-0-2000; IN COMMERCE 8-0-2000.

FOR: ELECTRICAL TAPES, NON-METAL CONDUIT GASKETS, IN CLASS 17 (U.S. CLS. 1, 5, 12, 13, 35 AND 50).

FIRST USE 2-0-2000; IN COMMERCE 2-0-2000.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "POWER", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS, IN PART, OF "POWER 1 FIRST".

SN 75-925,349, FILED 2-9-2000.

DAVID H. STINE, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

POWER FIRST

Reg. No. 4,428,924

Registered Nov. 5, 2013

Int. Cls.: 6, 9, 17 and 22

W.W. GRAINGER, INC. (ILLINOIS CORPORATION)
100 GRAINGER PARKWAY
LAKE FOREST, IL 60045

FOR: METAL CONDUIT; METAL NUTS; METAL PIPE COUPLINGS AND JOINTS, IN CLASS 6 (U.S. CLS. 2, 12, 13, 14, 23, 25 AND 50).

TRADEMARK

FIRST USE 11-0-2007; IN COMMERCE 11-0-2007.

PRINCIPAL REGISTER

FOR: ADAPTER PLUGS; CIRCUIT BREAKERS; COAXIAL CABLES; WIRE TERMINALS; ELECTRIC CONNECTORS; DISTRIBUTION BOXES FOR ELECTRICAL POWER; ELECTRIC SWITCHES; ELECTRIC OUTLETS; ELECTRIC PLUGS; ELECTRIC TERMINAL BLOCKS; PROTECTIVE COVERS FOR ELECTRIC SWITCHES; INSULATED ELECTRICAL CONNECTORS; INVERTERS; FLOOR POWER CABLE COVERS AND POWER CABLE PROTECTORS; SURGE PROTECTORS; HAND-HELD AND WHEELED STORAGE REELS FOR ELECTRIC WIRE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 2-0-1999; IN COMMERCE 2-0-1999.

FOR: ELECTRICAL TAPE; HEAT SHRINK TUBING FOR COVERING ELECTRICAL WIRE, IN CLASS 17 (U.S. CLS. 1, 5, 12, 13, 35 AND 50).

FIRST USE 3-0-2000; IN COMMERCE 3-0-2000.

FOR: PLASTIC CABLE TIES, IN CLASS 22 (U.S. CLS. 1, 2, 7, 19, 22, 42 AND 50).

FIRST USE 2-0-2013; IN COMMERCE 2-0-2013.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,660,099 AND 2,821,454.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "POWER", APART FROM THE MARK AS SHOWN.

SER. NO. 85-923,185; FILED 5-3-2013.



Lisa Street
Deputy Director of the United States Patent and Trademark Office

Reg. No. 4,428,924 CAITLIN WATTS-FITZGERALD, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

POWER FIRST

Reg. No. 4,388,987

Registered Aug. 20, 2013

Int. Cl.: 9

TRADEMARK

PRINCIPAL REGISTER

W. W. GRAINGER, INC. (ILLINOIS CORPORATION)
100 GRAINGER PARKWAY
LAKE FOREST, IL 600455201

FOR: BATTERIES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 11-0-2012; IN COMMERCE 11-0-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,660,099.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "POWER", APART FROM THE MARK AS SHOWN.

SN 85-581,982, FILED 3-28-2012.

SALLY SHIH, EXAMINING ATTORNEY



Sally Shih
Acting Director of the United States Patent and Trademark Office